

REMARKS

Applicants' undersigned counsel thanks Examiner Koehler for the very careful and thorough examination given the application, and also for the very courteous telephone interview conducted October 9, 2002. During the interview, Applicant agreed to amend the claims and the specification to overcome the Examiner's rejections under § 112. The § 102 rejection over Klos was also discussed, as further described below.

In this response applicant has provided a substitute specification because applicant believes the number and nature of the amendments to the specification would render it extremely difficult to understand were the specification to be amended in the traditional manner.

The abstract has been corrected to delete the reference to Fig. 2 according to the Examiner's requirements. Also, applicant has added new claims 37-61 to more clearly describe the invention. No new matter has been entered. Basis for the new claims can be found in the claims as filed.

Corrected drawings have been provided for Figs. 1-36, along with the required petition and fee. New copies of Figures 1 to 4 are included in triplicate as color photographs in compliance with 37 CFR § 1.84(b)(2). Black and white photocopies of the color photographs are also enclosed. In the original PCT filing (from which the parent of this continuation application claims priority), these photographs were presented in color. These color photographs are now filed to satisfy the requirements of 37 CFR 1.84. A petition to accept color photographs and appropriate fee are also included. Also, the text which originally appeared in Figs. 1-4 has been moved to the "Brief Description of the Drawings", along with translations of certain German terms in the substitute specification.

As required by 37 CFR 1.84, the substitute specification includes the form paragraph required at the beginning of the "Brief Description of the Drawings" section, indicating that at least one color photograph was filed in the case.

New copies of Figures 5 to 36 have been provided with a different identification key which clearly associates each profile with the proper element. Like the color photographs from Figs. 1-4, the graphs were originally presented in color, with colored lines and a color key. Transmission by black-and-white photocopy made it impossible to identify and distinguish the lines. Rather than petition the Office to accept color graphs, however, applicant has supplied a different key to the graph. The lines on the graphs are now identified either by marker symbols appearing on each line or by a different line style. Each line on

each graph has one representative marker symbol circled in red (as best as possible due to the close line proximity in some figures). In addition to these indications, all marker symbols in the key for each graph have been circled in red. The remaining marker symbols on the lines in the graphs were not marked in red due to their large number and close proximity; confusion rather than clarity would result if each marker symbol were marked. If, however, the Examiner would like every symbol marked, please notify the undersigned promptly.

It is requested that the Examiner consider these changes to the figures, and substitute the enclosed clean copies of all figures for the previously submitted figures.

The claims and the specification have been amended to clarify the invention. No new matter has been entered, either to the claims or to the specification.

The claims have been rejected under § 112, first paragraph for lacking antecedent basis in the specification. It is believed that the substitute specification submitted herewith now obviates all such § 112, first paragraph claim rejections.

The claims have also been rejected under § 112, second paragraph for indefiniteness. The claims have been amended and now overcome all of the § 112, second paragraph rejections. With respect to the rejection of claim 29 under this section, applicant notes that the claim recites "an average chromium content of more than approximately 5%" and a "chromium index greater than approximately 10." The claim does not recite an average chromium content greater than 1%; rather the chromium index is *defined* as the average chromium content of the conversion layer *greater than* (i.e. *in excess of*) 1% chromium, multiplied by the layer thickness in nanometers. Therefore, claim 29 is not indefinite.

The Examiner has indicated that claim 30 would be rejected for double patenting should claim 1 be found allowable. Applicant believes that claims 1 and 30 should be independently patentable. Claim 1 recites a degree of corrosion protection provided by the claimed chromium(VI)-free conversion layer, *even in the absence of* silicate, cerium, aluminum and/or borate. However, claim 1 does not *foreclose* the presence of the recited species. Claim 30, on the other hand, which depends from claim 1, *specifically forecloses the presence* of the recited species, reciting that the layer is "free from the presence of silicate, cerium, aluminum, and borate." Thus, claim 30 adds an additional limitation to the recitation of claim 1, and should be patentable as a separate dependent claim.

The Examiner has rejected the independent claims 1, 14, 20 and 24 under § 102 as being allegedly anticipated by Klos. During the telephone interview of October 9, 2002, this rejection over Klos was discussed. It was pointed out that Klos **does not** in fact teach or

suggest “at least 100 hours of corrosion resistance to metal articles subjected to a standard salt spray test,” as stated by the Examiner on page 18 of the Office action. The values listed as “100” in Table 3 refer, not to hours of corrosion resistance, but rather to percentage of white rust coverage. As explained during the interview (and agreed by the Examiner), Table 3 from Klos is properly read as described in the following paragraph.

Table 3 of Klos lists data for several salt spray tests conducted for a number oxalate-chrome solutions, with the corrosion resistance being measured at 4, 22 and 66 hours. (See Table 3, headings under “Hours Salt Spray”). The values listed in the table under the respective 4-, 22- and 66-hour Salt Spray test columns represent the percentage of the treated surface that had corroded after the allotted time in the Salt Spray test. So for example, reading from Table 3 in Klos, using an Oxalate-Chrome solution having a Mol/Mol ratio of 1.5 and a pH of 1.7, one-hundred percent (100%) of the treated surface was covered with corrosion after 4 hours of salt spray. Similarly, for an Oxalate-Chrome solution having a Mol/Mol ratio of 0.5 and a pH of 1.7, forty percent (40%) of the treated surface was covered with corrosion after 22 hours of salt spray.

Pending claim 1 recites (and claims 14, 20 and 24 have now been amended to recite) that the conversion layer presents a corrosion protection “of about 100 to 1000 h in the salt spray test according to DIN 50021 SS or ASTM B 117-73 until first attack according to DIN 50961 Chapter 10.” As explained above (and agreed during the interview), Klos neither teaches nor suggests such this limitation which has now been incorporated into all of the independent claims. Therefore, it is respectfully submitted that claims 1, 14, 20 and 24 are now in condition for allowance. All remaining claims are dependent claims, and should also be allowable for depending from an allowable base claim.


Therefore, all of the objections and rejections having now been overcome, Applicant respectfully submits that all claims are in condition for allowance, and notice to that effect is respectfully requested.

If there are any fees required by this communication not covered by an enclosed check, please charge such fees to our Deposit Account No. 16-0820, order No. 31716US1.

Respectfully submitted,

PEARNE & GORDON LLP

By


Steven J. Solomon, Reg. No. 48719

526 Superior Avenue East, Suite 1200
Cleveland, Ohio 44114-1484
Tel: (216) 579-1700
Fax: (216) 579-6073

Date: October 15, 2002